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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,763	12/19/2000	Uwe Hansmann	DE919990078	5393
46369	7590	04/07/2005	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			KANG, INSUN	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,763

Applicant(s)

HANSMANN ET AL.

Examiner

Insun Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the RCE amendment filed 3/23/2005.
2. As per applicant's request, claims 1, 11, and 16 have been amended. Claims 1-16 are pending in the application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 5-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 7 and 8, the term "adapted for" is unclear. It has been held that the recitation that an element is "adapted for" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Correction is required.

Claims 5, 6, 13, and 16 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

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trade name. In the present case, the trademark/trade name is used to identify/describe a JAVA and, accordingly, the identification/description is indefinite.

Per claims 7-10, it is unclear whether these claims further limit the claims 1 and 4 or they are the system and computer program product versions of claims 1 and 4. The former is used for interpretation.

Per claim 11, the word "preferably" makes the claim unclear whether the bit-length does not need to be either 8 or 16 bits. It is interpreted as: "any bit-length" can be used.

Per claims 14 and 15, the claims only recite the capability of the set of software components, without actual performance. It is unclear whether the set of software components is actually "partly or entirely assembled" or is only capable of being "partly or entirely assembled." The later is used for interpretation.

Per claim 16, it is unclear how such accessing, by the apparatus with a limited Java Virtual Machine, a full Java Virtual Machine is performed and how assigning the identifier in claim 1 further limit claim 16, as the full JVM is not supported on the Java Card due to limited memory resources. Although the applicant argues that the "aspect added was already present by virtue of the fact that the accessing aspect recites "by said apparatus"... which has already been designated in the providing aspect as having a limited Java Virtual machine (Remark, page 5)," the claim merely recites accessing by a limited JVM without further explaining how such accessing is performed and related to the assigned/stored identifier.

As per claim 12, this claim is rejected for dependency on the above rejected parent claim 11.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Giorgio et al. hereinafter referred to as "Giorgio."

Per claim 1:

Giorgio discloses:

-providing a set of software components out of which a software application to be executed by an apparatus comprising processor means and memory means can be partly or entirely assembled (i.e. "Users can load Java Cards directly. This means custom applications can be added to the card," page 2, Why openCard?)

-said software components are self-contained, reusable software units that can be visually composed into applets or applications using visual application builder tools ("applets... Java Plug-in... Java Card application and loads it onto the card or iButton," page 4)

-assigning a different numeric identifier to each component of said set of software components ("AIDs (application identifiers)," page 4 last paragraph)

-and storing each assigned numeric identifier in the corresponding component ("AIDs

(application identifiers),” page 4 last paragraph)

as claimed.

Per claim 2:

The rejection of claim 1 is incorporated, further, Giorgio discloses that the numeric identifier comprises a bit-length of 8 or 16 bit (See page 8, code assigning an AID with 0 to 16 bytes).

Per claim 3:

The rejection of claim 1 is incorporated, further, Giorgio discloses:

-loading two or more software components of said set of software components into said memory means of said apparatus, and storing said two or more software components therein (i.e. “Users can load Java Cards directly. This means custom applications can be added to the card,” page 2, Why openCard?) as claimed.

Per claim 4:

The rejection of claim 3 is incorporated, further, Giorgio discloses:

-loading said software application into said apparatus and storing said software application in said memory means; providing means for instantiating said loaded components upon request of said software application ; loading said means for instantiating into said apparatus; and storing said means for instantiating in said memory means (i.e. “Users can load Java Cards directly. This means custom applications can be added to the card,” page 2, Why openCard?) as claimed.

Per claim 5:

The rejection of claim 1 is incorporated, further, Giorgio discloses providing said apparatus with a full Java Virtual Machine being able to execute every Java instruction (i.e. "the advantages of having an all-Java development environment," page 20 first paragraph) as claimed.

Per claim 6:

The rejection of claim 1 is incorporated, further, Giorgio discloses -providing said apparatus with a limited Java Virtual Machine being able to execute only certain Java instructions ("Java Card," page 20 paragraph 1) as claimed.

Per claim 7:

The rejection of claim 1 is incorporated, further, Giorgio discloses a system comprising means adapted for carrying out the steps of claim 1 (i.e. see the CyberFlex card code) as claimed.

Per claim 8:

The rejection of claim 4 is incorporated, further, Giorgio further discloses a system comprising means adapted for carrying out the steps of claim 4 (i.e. see the CyberFlex card code) as claimed.

Per claim 9:

The rejection of claim 1 is incorporated, further, Giorgio discloses a computer program

product loadable into memory means of a digital computer, comprising software code for performing the steps of claim 1 (i.e. see the CyberFlex card code) as claimed.

Per claim 10:

The rejection of claim 4 is incorporated, further, Giorgio further discloses a computer program product loadable into memory means of a digital computer, comprising software code for performing the steps of claim 4 (i.e. see the CyberFlex card code) as claimed.

Per claim 11, it is the device version of claim 2, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 2 above.

Per claim 12, this claim is device version of the claimed method discussed in claim 4, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 13:

The rejection of claim 11 is incorporated, further, Giorgio discloses that the device comprises at least one of a chip card, a set-top box and a Personal Digital Assistant ("Java Card," page 20 paragraph 1) as claimed.

Per claim 14:

The rejection of claim 1 is incorporated, further, Giorgio discloses that said set of software components is capable of at least one of being, subsequent to being partly or entirely assembled into the software application, updated by updating at least one

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software component of the set of software components and supplemented by adding at least one software component to the set of software components (i.e. "Users can load Java Cards directly. This means custom applications can be added to the card," page 2, Why openCard?) as claimed.

Per claim 15, it is the device version of claim 14, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 14 above.

Per claim 16:

Giorgio discloses providing said apparatus with a limited Java Virtual Machine being able to execute only a subset of Java instructions ("Java Card," page 20 paragraph 1); and accessing, by said apparatus with a limited Java Virtual Machine, a full Java Virtual Machine residing at a computing unit coupled to said apparatus, said accessing allowing said apparatus to execute additional Java instructions (i.e. "the advantages of having an all-Java development environment," page 20 first paragraph) as claimed.

Response to Amendment

7. Per claims 3 and 4 of the amendment, the "Previously presented" identifier needs to be used, as there is no new added limitation in the amendment.

Per claim 16 of the amendment, the "Currently amended" identifier needs to be used as the phrase, "with a limited Java Virtual Machine" has been added.

Response to Arguments

8. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724. The examiner can normally be reached on M-F 7:30-4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 571-272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

I. Kang
Examiner
4/4/2005

Kakali Chaki

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